



PATENT
Docket No. 1776-4054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nakata, K. et al. Group Art Unit: 1773
Serial No.: 09/485,002 Examiner: Chen, V.
Filed: January 31, 2000
For : BIODEGRADABLE POLYESTER COMPOSITION, BIODISINTEGRABLE RESIN COMPOSITION, AND MOLDED OBJECTS OF THESE

Box Non-Fee Amendment
Commissioner Of Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement mailed June 19, 2001, applicants present the following remarks. Claims 1-67 are pending in this application and were subjected to a Restriction Requirement. The Examiner contends that the claims describe the following inventions:

Group I, claim(s) 1-17, drawn to a first biodegradable polyester composition and articles thereof.

Group II, claim(s) 18-24, drawn to a biodegradable card.

Group III, claim(s) 25-29, drawn to a first biodegradable laminate.

Group IV, claim(s) 30-35, drawn to a second biodegradable laminate.

Group V, claim(s) 36-42, drawn to a third biodegradable multilayer film.

Group VI, claim(s) 43-47, drawn to a biodegradable film.

Group VII, claim(s) 48, drawn to a cushion material with a first base film.

Group VIII, claim(s) 49-52, drawn to a cushion material with a second base film.

Group IX, claim(s) 53-58, drawn to particles with a first biodegradable coating.

Group X, claim(s) 59-62, drawn to particles with a second coating.

Group XI, claim(s) 63-67, drawn to a biodegradable resin composition.

The Examiner contends that a common feature in inventions I-IX is the use of polycaprolactone, which is known in the art, and, therefore, does not meet the requirement for unity of invention. The Examiner also contends that a common feature in invention I-III, V-IX, and XI is the use of an aliphatic polyester and a polycaprolactone, which are known in the art, and, therefore do not meet the requirement for unity of invention. Applicants respectfully traverse this Restriction Requirement.

Claims to Groups I-III, V-IX, and XI describe biodegradable compositions comprising polycaprolactone and aliphatic polyester resins in specific ratios. This combination of features has not been shown not unique over the prior art. Thus, restriction of inventions I-III, V-IX, and XI appears improper. Applicants elect, with traverse, claims 1-17 to be examined, and request reconsideration and withdrawal of the restriction requirement, at least as it pertains to Groups I-III, V-IX and XI.

No additional fee is believed necessary. The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1776-4054.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 19, 2001

By:

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CERTIFICATE OF MAILING (37 C.F.R. §1.8(a))

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Sir:

I hereby certify that the attached:

1. Response To Restriction Requirement (2 pages); and
2. Return Postcard.

along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on date shown below with sufficient postage as first-class mail in an envelope addressed to the: Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C., 20231.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 19, 2001

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